

REMARKS

This Amendment is in response to the Office Action mailed December 18, 2002. Claims 1, 3, 4, 19, 21 and 22 are amended as shown above. Claims 2, 6, 9 and 20 are cancelled. Claims 1, 3-5, 7, 8, 10-19 and 21-26 remain pending in the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims in view of the above amendments and the following remarks.

Claim Objections

The Examiner objected to claim 9 under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. According to the Examiner, claim 9 discloses the same limitation disclosed in line 3 of claim 1. The Examiner required that claim 9 be cancelled, amended to place it in proper dependent form, or re-written in independent form.

In this amendment, Applicant has complied with the Examiner's requirement and cancelled claim 9. Applicant submits that this overcomes the Examiner's objection, and respectfully requests withdrawal of the objection.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claim 3 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and claim the subject matter the Applicant regards as the invention. According to the Examiner, it is unclear how the identifier label is attached to the device in which the component is installed, as recited in claim 3, where claim 1 discloses that the identifier is encoded in a component. The Examiner believed there is a discrepancy as to where the label is located.

Applicant respectfully traverses the Examiner's rejections. Claim 1, as amended, recites an article of manufacture combination comprising a component container and "first and second labels removably affixed to the component container, each label having printed thereon an identifier that uniquely identifies a component inside the component container, the identifier being electronically stored in the component and read therefrom for printing on the labels." Claim 3, as amended, recites the combination of claim 1 wherein "the first label can be removed from the component container and attached to a device in which the component is installed."

There is thus no discrepancy as to the location of the label. The unique identifier is electronically stored in the component, and that electronically stored identifier is read and used to print the first and second labels. The first and second labels are removably attached to the component container, such that after they are printed they can be removed and put elsewhere. In claim 3, the first label can be removed from the component container and placed on a device into which the component is installed. In view of the above explanation, Applicant submits that there is therefore no discrepancy between claims 1 and 3, and respectfully requests withdrawal of the rejection.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1-6, 9, and 19-24 under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, U.S. Patent No. 5,900,610 to Kelly, Jr. ("Kelly"), and rejected claims 7, 8, 25 and 26 as being unpatentable under 35 U.S.C. § 103(a) over Kelly in view of U.S. Patent No. 6,438,685 to Brower et al ("Brower"). According to the Examiner, Kelly discloses all elements and limitations of the claim, except for an identifier encoded in a container. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to place the identifier label in any location or on the component, since it has been held that re-arranging parts of an invention involves only routine skill in the art.

Applicant respectfully traverses the Examiner's rejections. To establish a *prima facie* case of obviousness, three criteria must be met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. As further explained below, the Examiner has not established a *prima facie* case of obviousness because criteria (1) and (2) have not been met.

Kelly discloses an apparatus and method for tracking inventory of multiple goods in multiple shipping cartons. Specifically, Kelly describes a system for tracking shoe inventory. Each pair of shoes is packed within a shoe box 20, and a plurality of shoe boxes 20 are then packed into a shipping carton 24. A main label 30 is applied to shoe boxes 20. The main label 30 has a single secondary label 40 thereon and is configured to be placed around a corner of the shoe box 20, such that an end portion or tab 56 of secondary label 40 extends outwardly and is

grippable by a worker; this allows the worker to peel off the secondary label 40 and separate it from the main label 30. At a distribution center, the labeled shoe boxes 20 are sent down a production line in a known sequence of styles and sizes, and in groups bound for particular destinations. Each of the groups is packed in one or more cartons 24. The workers pack the cartons 24 in the order in which the shoe boxes 20 are transported down the line and then remove the secondary label 40 from the last shoe box 20 placed in the carton 24 and apply the removed secondary label 40 to the carton 24. Because the sequence of styles and sizes are known, the contents of any particular carton 24 can be readily determined by knowing the identities of the first and last shoe boxes 20 placed into the carton 24.

Claim 1, as amended, recites an article of manufacture combination comprising a component container and “first and second labels removably affixed to the component container, each label having printed thereon an identifier that uniquely identifies a component inside the component container, the identifier being electronically stored in the component and read therefrom for printing on the labels.” Contrary to the Examiner’s assertion, the claimed combination is not simply a re-arrangement of parts of the invention; Kelly does not teach all elements and limitations in the recited combination, and therefore a re-arrangement of its elements could not result in the claimed invention. Kelly discloses that a main label having a single secondary label is attached to the exterior of a shoe box, and that only the single secondary label can be removed from the shoe box and placed on a shipping carton into which the shoe box is placed. Because Kelly teaches that only the single secondary label is removable from the main label, it cannot disclose, teach or suggest “first and second labels removably affixed to the component container.” Further, Kelly does not disclose, teach or suggest any particular source for the information printed on the label, and therefore cannot suggest the claimed combination where the identifier is printed on a plurality of labels, “the identifier being electronically stored in the component and read therefrom for printing on the labels.”

In addition to not disclosing every element and limitation recited in the claim, Kelly provides no suggestion or motivation to modify the apparatus disclosed therein to arrive at the claimed invention. Specifically, Kelly does not teach or suggest the use of multiple removable labels. Kelly also does not teach or suggest that the information printed on the main or secondary label should come from any particular source. In view of the above, Applicant

submits that Kelly cannot render obvious the claimed combination, and respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claims 3-5, 7 and 8, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance. Applicant therefore respectfully submits that claims 3-5, 7 and 8 are allowable by virtue of their dependence on allowable claim 1 and by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Claim 19, as amended, recites an article of manufacture comprising a base label having a designated area thereon to receive an identification label, and “first and second identification labels removably attached to the designated area of the base label, each identification label having printed thereon an identifier that uniquely identifies a component inside a component container to which the base label can be attached, the identifier being electronically stored in the component and read therefrom for printing on the identification labels.” As discussed above in connection with claim 1, Kelly does not disclose, teach or suggest the elements and limitations of the claimed combination. Applicant therefore submits that Kelly cannot render obvious the claimed combination, and respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claims 21-26, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 19 is in condition for allowance. Applicant therefore respectfully submits that claims 20-26 are allowable by virtue of their dependence on allowable claim 19 and by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Conclusion

None of the references singly or in any motivated combination disclose, teach, or suggest what is recited in the independent claims. Thus, given the above amendments and accompanying remarks, independent claims 1 and 19 are now in condition for allowance. The dependent claims that depend directly or indirectly on these independent claims are likewise allowable based on at least the same reasons and based on the recitations contained in each dependent claim.

If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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APPENDIX A – CLAIMS MARKED-UP REPLACEMENT CLAIMS

Pursuant to 37 C.F.R. § 1.121(c), the amended claims shown below in marked-up form correspond to the clean claims found in the amendment.

1. (Amended) An article of manufacture comprising:

a component container; and

[a plurality of labels removably affixed to the component container and having printed thereon an identifier, wherein the identifier is encoded in a component inside the component container and uniquely identifies the component.]

first and second labels removably affixed to the component container, each label having printed thereon an identifier that uniquely identifies a component inside the component container, the identifier being electronically stored in the component and read therefrom for printing on the labels.

3. (Amended) The article of manufacture of claim [2] 1 wherein the first label [is] can be removed from the component container and attached to a device in which the component is installed.

4. (Amended) The article of manufacture of claim [2] 3 wherein the second label [is] can be removed from the component container and attached to a package in which the device is shipped.

19. (Amended) An article of manufacture comprising:

a base label having a designated area thereon to receive an identification label;
and

[a plurality of identification labels removably attached to the designated area of the base label, wherein the identification labels have printed thereon an identifier which uniquely identifies a component inside a component container to which the base label can be attached.]

first and second identification labels removably attached to the designated area of the base label, each identification label having printed thereon an identifier that uniquely

identifies a component inside a component container to which the base label can be attached, the identifier being electronically stored in the component and read therefrom for printing on the identification labels.

21. (Amended) The article of manufacture of claim [20] 19 wherein the first label [is] can be removed from the component container and attached to a device in which the component is installed.
22. (Amended) The article of manufacture of claim [20] 21 wherein the second label [is] can be removed from the component container and attached to a package in which the device is shipped.